

REMARKS

In this submission the Applicants reiterate the position expressed in the After Final response. More specifically, the rejection of claims 1, 7, 13, 16 and 20 under 35 USC § 103(a) as being unpatentable over Takakado et al. in view of Ivner et al., is again traversed.

In the final rejection, it is acknowledged that Takakado et al. does not explicitly show that the inverter has a neutral output. To overcome this shortcoming, Ivner et al. is cited. Ivner et al. is held to disclose that "for the purpose of manufacturing a lower cost converter that part of the converter 8 has a neutral output" and Fig. 1 is advanced as showing this feature.

However, there are two elements #2 disclosed in Ivner et al. which can be taken as outputs. These are disclosed as being terminals which are intended to respectively act as positive and negative output terminals. Further, Ivner et al. is completely silent as to the either of the terminals 2, 2 being "neutral." In this connection attention is again called to column 4, lines 9 – 28 wherein it is stated that:

A device for **converting current voltage between a first one-phase side 1, which is illustrated through two terminals 2, and a second three-phase side 3** is illustrated in FIG. 1. Such a device is suited for being a part of a power converter station **for delivering electrical energy from a three-phase line to a single-phase railway supply line for electrically driver vehicles** or conversely. The device has at the second side a transformer 4, with three primary windings 5, single for each phase, and three secondary windings 6 galvanically separated from each other. Thus, the transformer is arranged to transform the alternating voltage of one phase to an alternating voltage of another level through each couple of primary winding/secondary winding. In the case of a power converter station of the type mentioned, the voltage of the three-phase line is about 20 kV, and this is

transformed to about 2,5 kV alternating voltage between the ends of the respective secondary winding, so that the components arranged in the converter modules described hereinafter will not be damaged. (Emphasis added)

Ivner et al. does not mention the term “neutral.” Therefore, there is nothing in this reference that would remotely suggest a “neutral output” and nothing to induce any consideration by a hypothetical person of ordinary skill of transferring any teachings of Ivner et al. into the arrangement of Takakado et al. Indeed, without mention of a neutral output there is nothing that would prompt the vaguest consideration that one of the two terminals 2, could be what is purported in the final rejection or that any part/arrangement of Ivner et al. might find advantageous use in the Takakado et al. arrangement.

It is respectfully submitted that the position that Ivner et al. discloses a neutral output is in error and renders any rejection based on this reference, untenable for at least this reason.

Takakado et al. discloses two outputs in the load port. Ivner et al. discloses two outputs in the load port. Neither of the references disclose a third output which would seem to be critical if the position taken the final rejection were to be tenable.

Further, it is not seen that an alleged reduction in the cost of part of the converter would result from actually increasing the number of parts (i.e. adding a third output to the load port) nor would amount to any form of motivation to induce consideration of a complete revision of the circuit arrangement disclosed in Takakado et al.

In order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

There are three possible sources for motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) This case law, however, establishes that, irrespective of

the elements which are disclosed, without a motivation to combine, a rejection attempting to establish a *prima facie* case of obvious must be held improper. Additionally, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In this instance, "cost" would, at the very best, merely be attributable to the level of skill in the art, and thus not be available as a suggestion to combine.

The rejections advanced in paragraphs #3-7, inasmuch as they are all founded on the basic combination of Takakado et al. and Ivner et al., all suffer from the same tenability eliminating shortcomings and are summarily traversed on at least this basis.

New claims are presented for examination. These claims are patentable in that they define subject matter which is neither disclosed nor suggested by the art applied. For example, new claim 25 calls for the load port to have first and second outputs in addition to the neutral output. Neither of Takakado et al. or Ivner et al. show such a structure. New claim 26 calls for the Ivnerter to comprise four legs, wherein a first leg is connected to ground, a second leg is connected to a first output of the load port, a third leg is connected to the neutral output of the load port and a fourth leg is connected to a second outlet of the load port. Clearly none of the art which is applied can meet these requirements.

Support for the new claims is of course found in the drawings and the written specification and pending claims.

Conclusion

It is respectfully submitted that the incorrect assertion that Ivner et al. discloses a neutral output renders the rejection untenable. In addition the totally unsupported position that this feature alone has a direct effect on the cost savings which are advanced as being possible with the arrangement of Ivner et al, is such as prevent a *prima facie* case of obviousness being established.

It is therefore respectfully submitted that the claims as they stand before the PTO are allowable over the art of record for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

Respectfully submitted,

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